

Application No. 09/921,097
Amendment dated December 20, 2006
Reply to Office Action of June 20, 2006

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REMARKS

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Applicant amended claims 1, 16, 31, 43, 55, and 59 to further define Applicant's claimed invention. Support for the amendments to claims 1, 16, 31, 43, 55, and 59 is found in the specification at least on page 13, line 7 to page 14, line 8 and in FIG. 4.

In the Office Action, the Examiner rejected claims 1-6, 8, 10-15, 31-33, 35 and 37-42 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,483,986 to Krapf ("Krapf") in view of U.S. Patent No. 5,929,849 to Kikinis ("Kikinis").

Independent claim 1, as now amended, recites the steps of "delivering a video to and displaying the video on a visual display," "interrupting the delivery and display of the video at a point in time," and "continuing the delivery and display of the video from the point in time where the delivery and display of the video was interrupted after the interaction by the user." Independent claim 31, as now amended, recites the steps of "delivering a video to and displaying the video on a visual display," and "interrupting the display and the delivery of the video at a point in time." No such method is taught or suggested by Krapf and Kikinis, either alone or when properly combined.

Krapf teaches that "system 1 includes a personal video recorder 2 connected through a data line 18 to a display 4" and that "upon selection by a viewer of the alternative subject matter data 14, the personal video recorder 2 stores the streaming video data." (Krapf, col. 3, lines 33-35 and 50-52). Krapf discloses interrupting the display, but not interrupting the delivery of video. Krapf does not teach or suggest interrupting both "the delivery and display of the video at a point in time" as recited in independent claims 1 and 31.

Kikinis states that "[o]nce a viewer activates the system of the invention, and connection is made to the BMW WEB server, action may proceed in one of several ways. In one embodiment, the TV display is suspended, and the initial WEB page downloaded from the BMW server is displayed instead. Preferably, the TV display continues, and the WEB page downloaded is displayed in a window 71 over the TV display as shown in FIG. 2C" (Kikinis, col. 8, lines 1-8). Fig. 2C of Kikinis shows that

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the video stream (BMW commercial) is displayed after the advertisement content 71 is selected by a user. Kikinis states that the display of the video can be suspended. (Kikinis, col. 8, lines 3-4). Kikinis does not teach or suggest "interrupting the delivery and display of the video at a point in time" as recited in independent claims 1 and 31.

Applicant submits that the Examiner's rejection of claims 1-6, 8, 10-15, 31-33, 35, and 37-42 under 35 U.S.C. § 103(a) as being unpatentable over Krapf in view Kikinis has been overcome.

The Examiner rejected claims 16-19, 27, and 28 under 35 U.S.C. 103(a) as being unpatentable over Krapf in view of U.S. Patent No. 6,628,302 to White ("White").

Independent claim 16, as now amended, recites the steps of "delivering a video from a remote location over a network to a visual display and displaying the video on the visual display," "pausing said step of delivering and displaying the video from the remote location at a point in time," and "continuing the delivery and display of the video from the point in time the delivery of the video and display of the video was paused after the interaction by the user."

As discussed above, Krapf does not teach or suggest "interrupting the delivery and display of the video at a point in time." White teaches interrupting the delivery of the on-demand video by pressing a button on the remote control "if a user wishes to stop or pause delivery of the on-demand video (e.g. to answer the telephone, or get a snack from the kitchen." (White, col. 4, line 65 to col. 5, line 1). However, White does not teach or suggest interrupting the display of the video on the screen. Thus, White fails to teach or suggest interrupting both "the delivery and display of the video at a point in time" as recited in independent claim 16.

Moreover, Applicant respectfully submits that the combination of Krapf and White is untenable because the proposed modification renders the prior art unsatisfactory for its intended purpose. (See MPEP § 2143.01(V): "[i]t is well accepted that, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to

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make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984").

As discussed above, Krapf teaches a system including a video recorder which records streaming video data, such as live TV, while the user watches alternative subject matter data, such as an advertisement, on the display. White teaches pausing the delivery of streaming on-demand video data with a pause button. Applicant submits that the Krapf system cannot be modified with a pause button disclosed in White for at least two reasons. One, live TV cannot be paused. The intended purpose of the Krapf system is to record streaming video data with a video recorder while the selected advertising content is delivered and displayed to a user. Two, if the delivery of streaming video data could be stopped in Krapf, then the personal video recorder would be useless. It is respectfully submitted that the Examiner's proposed modification of Krapf would render the Krapf system unsatisfactory for its intended purpose. Thus, Applicant respectfully submits that there is no suggestion or motivation to make the proposed modification.

Further, Applicant submits that the proposed combination of Krapf and White is untenable because Krapf and White teach away from each other. (See MPEP § 2145(X)(D), "References Cannot Be Combined Where Reference Teaches Away from Their Combination." As discussed above, Krapf teaches toward interrupting the display of live TV, recording the stream of live TV video data with a video recorder while the user watches a selected advertisement, and continuing the display of TV video data on a time delay. (Krapf, col. 3, lines 33-35 and 50-52 and Fig. 2). Conversely, White teaches toward delivering and displaying an on-demand video to a user and interrupting the delivery of the video with a pause button. (White, col. 4, line 65 to col. 5, line 1). Thus, Applicant submits that Krapf and White are directed to different technologies and teach away from each other such that their combination is improper.

Applicant submits that the Examiner's rejection of claims 16-19, 27, and 28 under 35 U.S.C. 103(a) as being unpatentable over Krapf in view of White has been

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overcome.

The Examiner rejected claims 20, 21, 23, 25, 26, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Krapf and White as applied to claim 16 above, and further in view of Kikinis. Applicant submits that the rejections of claims 20, 21, 23, 25, 26, 29, and 30 are rendered moot at least because they depend from an allowable independent claim, or claims dependent therefrom.

The Examiner rejected claims 55 and 56 under 35 U.S.C. § 103(a) as being unpatentable over Kikinis in view of Krapf and White.

Claim 55, as now amended recites the steps of "delivering a video from a remote site and displaying the video on a visual display," "interrupting the delivery and the display of the video from the remote site after the interface link is interacted with," and "continuing the step of delivering and displaying the video from the point in time where the delivery and display of video was interrupted after accessing the commerce site.

Claim 55, as now amended includes the element present in amended claims 1, 16 and 31, i.e., the step of "interrupting the delivery and the display of the video." Applicant respectfully submits that claim 55 as amended is allowable over the cited references at least for the same reasons that independent claims 1, 16, and 31 are allowable. Applicant submits that the rejection of claim 56 is rendered moot at least because it depends from allowable claim 55. Applicant further submits that the Examiner's rejection of claims 55 and 56 under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Krapf and White has been overcome.

The Examiner rejected claims 59-63 and 65 under 35 U.S.C. § 103(a) as being unpatentable of Kikinis in view of White and Krapf.

Claim 59 as now amended recites the step of "creating a link program adapted to interrupt the delivery of video from the remote storage medium to a visual display and to interrupt the display of the video on the visual display at a second site, the link program providing access to ancillary content accessible over a network, the link program linking the ancillary content and the video to the point in time when the delivery and the display

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of the video was interrupted."

Claim 59, as now amended, includes the element present in amended claims 1, 16, 31, and 55, i.e., the interruption of the delivery of a video to a visual display and the interruption of the display of the video on a visual display. Applicant respectfully submits that claim 59 as amended is allowable in view of the cited references at least for the same reasons that claims 1, 16, 31 and 55 are allowable. Applicant submits that the rejection of claims 60-63 and 65 is rendered moot at least because they depend from an allowable independent claim, or claims dependent therefrom. Applicant further submits that the Examiner's rejection of claims 59-63 and 65 under 35 U.S.C. 103(a) as being unpatentable over Kikinis in view of Krapf and White has been overcome.

The Examiner rejected claims 43-45, 47, 49-54 and 64 under 35 U.S.C. § 103(a) as being unpatentable over Krapf and Kikinis in view of U.S. Publication No. 2002/0007493 to Butler ("Butler").

Claim 43 as now amended recites the step of "delivering a video to and displaying the video on a visual display" and "interrupting the display and the delivery of the video at a point in time." Claim 43, as now amended, includes the element present in amended claims 1, 16, 31, 55 and 59, i.e., "interrupting the display and the delivery of the video at a point in time." The Examiner's rejections of claims 1, 16, 31, 55 and 59 in view of Krapf and Kikinis have been traversed above. The Examiner relies on Butler for the teaching of "displaying content based on timing specifications for the advantage of indicating times for displaying content relative to the video stream." (See Office Action, page 24). Butler fails to teach or suggest the "interrupting the display and the delivery of the video at a point in time" limitation present in Applicant's claim 43.

Applicant respectfully submits that claim 43 as amended is allowable over Krapf and Kikinis in view of Butler for at least the same reasons that claims 1, 16, 31, 55 and 59 are allowable. Applicant submits that the rejection of claims 44-45, 47, 49-54 and 64 is rendered moot at least because they depend from an allowable independent claim, or claims dependent therefrom. Applicant further submits that the Examiner's rejection of

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claims 43-45, 47, 49-54 and 64 under 35 U.S.C. 103(a) as being unpatentable over Krapf and Kikinis in view of Butler has been overcome.

The Examiner rejected claims 7 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Krapf and Kikinis as applied to claims 1 and 31 above, and further in view of U.S. Patent No. 6,154,738 to Call ("Call"); rejected claim 22 under 35 U.S.C. § 103(a) as being unpatentable over Krapf and White as applied to claim 16 above, and further in view of Call; rejected claim 46 under 35 U.S.C. § 103(a) as being unpatentable over Krapf, Kikinis, and Butler as applied to claim 43 above, and further in view of Call; rejected claims 9 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Krapf and Kikinis as applied to claims 1 and 31 above, and further in view of U.S. Patent No. 6,184,878 to Alonso ("Alonso"); rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Krapf and White as applied to claim 16 above, and further in view of Alonso; and rejected claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Krapf, Kikinis, and Butler as applied to claim 43 above, and further in view of Alonso. Applicant submits that the rejections over claims 7, 9, 22, 24, 34, 36, 46, and 48 are rendered moot at least because they depend from an allowable independent claim, or claims dependent therefrom.

Applicant submits that independent claims 1, 16, 31, 43, 55 and 59 are patentable and that dependent claims 2-15, 17-30, 32-42, 44-54, 56 and 60-65 dependent from independent claim 1, 16, 31, 43, 55, or 59, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

In view of the foregoing remarks, it is respectfully submitted that the claims, as amended, are patentable. Therefore, it is requested that the Examiner reconsider the outstanding rejections in view of the preceding comments. Issuance of a timely Notice of Allowance of the claims is earnestly solicited.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any

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fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

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